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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/610,216 | 07/05/2000 | Roland D. Tai | 1624.001A | 4737 |

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| EXAMINER | |
|---|---|
| KEMPER, MELANIE A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3622 | |

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 09/610,216 | TAI, ROLAND D. |
| | Examiner | Art Unit |
| | M Kemper | 3622 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *18 and 40-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18 and 40-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 40-41, 46-48, 53 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Smith et al., patent number 5,995,942.

Smith et al. teaches a system and method of providing promotions comprising: a promotion carrier with information of a plurality of promotions and having a machine readable code which identifies the promotion carrier and associated with products having machine readable code(s) (fig. 6, col. 5, lines 24-26, col. 8, lines 1-10); a reading device capable of reading the code and product codes and configured to provide a data signal bearing information indicative of the carrier and the selected products (col. 5, lines 24-26, col. 7, lines 55-62, col. 8, lines 1-10); and a computer facility capable of receiving the data signal and configured to determine if the carrier contains a redeemable promotion for a selected product (col. 8, lines 1-10). Smith also teaches the code is a bar code (figure 6) and the scanner reads the bar codes. Smith also teaches a data analysis facility which analyzes the data to determine predetermined aspects of the use of the carrier (col. 8, lines 12-20).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 18, 42, 45, 49, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lapa et al., patent number 5,353,218 in view of Smith.

De Lapa teaches providing a reward offer to preselected customers each reward offer bearing an associated machine sensible code (col. 4, lines 45-50); sensing the stream of data signals being communicated between the checkout terminal and a data storage computer facility (col. 3, lines 53-55, col. 10, lines 5-15); temporarily storing in accessible temporary storage data corresponding to successive portions of the stream of data signals (col. 7, lines 50-65); sensing each occurrence of a data signal provided by the sensing of the code (col. 7, lines 50-65); selecting from the accessible temporary storage each group of data corresponding to signals occurring during each completed transaction where there is an occurrence of data provided by the sensing of the code (col. 7, lines 55-65); and analyzing each such group of selected data for determining predetermined aspects regarding each completed transaction (col. 10, lines 40-60). Smith teaches a code identifying a reward offer and an offer for sale of a plurality of products (col. 5, lines 24-27, fig. 6). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used an offer code as in Smith in the system of De Lapa since the code of Smith uses the identifying code as a functional equivalent to the customer code as used in De Lapa and since the offer code of Smith would have overcome the need of replacing the customer id in De Lapa. It also would have been obvious to have removed data corresponding to transactions devoid of the

data signal provided by the sensed code since this would have freed memory of unused data. De Lapa teaches a checkout terminal associated with the reading device to receive payment for the products wherein the computer facility generates a subtotal, subtracts valid promotions and generates the bill (col. 8, lines 10-15). It would have been obvious to have configured the computer facility in Smith to generate the subtotal, discount, and bill as in De Lapa since performing these steps at a computer facility would have been adopted for the intended purpose of product look up and payment generation in Smith.

5. Claims 43-44, 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Day et al., patent number 6484146.

Smith teaches the invention as described above, but does not show identifying the detected promotion as a valid promotion if it has not already been presented. Day teaches that a household may receive the reward offers and can take advantage of combined purchasing power (col. 6, lines 55- col. 7, line 10). It would have been obvious to one having ordinary skill in the art at the time of the invention to have identified promotions as valid if not already presented in Smith in order to allow a household to participate in the reward offer while preventing double couponing (using the same offer more than once).

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M Kemper
Primary Examiner
Art Unit 3622

MK